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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/995,298	11/27/2001	Dale Everett Steele	6016-3	8997

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EXAMINER

CHARLES, DEBRA F

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



Office Action Summary

Application No.

09/995,298

Applicant(s)

STEELE ET AL.

Examiner

Debra F. Charles

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/27/01</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-15 and 32-58 are rejected under 35 U.S.C. 101 because the bodies of the claims do not recite technology, i.e. computer implementation or any other technology in a non-trivial manner. *In re Toma*, 197 USPQ 852 (CCPA 1978). *Ex parte Bowman* 61 USPQ2D 1669.

For a claim to be statutory under 35 USC 101 the following two conditions must be met:

1) The claimed invention must produce a "useful, concrete, tangible result" (*In re Alappat*, 31USPQ2d 1545, 1558 (Fed. Cir. 1994) and *State Street vs. Financial Signature Group Inc.*, 47 USPQ2d 1596' 1601-02 (Fed Cir. 1998));

AND

2) The claimed invention must utilize technology in a non-trivial manner (*Ex parte Bowman*, 61 USPQ2d 1665, 1671 (Bd. Pat. Pat. App. & Inter. 2001)).

As to the technology requirement, note MPEP 2106 IV B 2(b). Also note *In re Waldbaum*, 173USPQ 430 (CCPA 1972) which teaches "useful arts" is synonymous with "technological arts". In *Musgrave*, 167USPQ 280 (CCPA 1970), *In re Johnston*, 183USPQ 172 (CCPA 1974), and *In re Toma*, 197USPQ 852 (CCPA 1978), all teach a technological requirement.

In *State Street*, "in the technological arts" was never an issue. The invention in the body of the claim must recite technology. If the invention in the body of the claim is not tied to technological art, environment, or machine, the claim is not statutory. *Ex parte Bowman* 61USPQ2d 1665,1671 (BD. Pat. App. & Inter.2001)(Unpublished).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1,2,7, 8,9,10, 11,12, 13,14,15,16, 17,18,23,24,25,26,27,28, 32,34,35, 36,37, 38, 40-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al.(5794207) and Motoyama(5913202).

Re claims 1, 13, 17, and 32: Walker et al. disclose a method comprising the steps of:
compiling client files, including data sets that contain personal information that uniquely identify clients and data sets that contain general information that do not uniquely identify the clients(Abstract, col. 8, lines 25-67);
without revealing the client's personal information, enabling suppliers to select subsets of clients based upon the client's general

information(col. 12, lines 20-35, col. 13, lines 10-25, col. 26, lines 50-67, col. 27, lines 1-20);

Walker at al. disclose(s) the claimed invention except receiving pre-approved offers from said suppliers on behalf of the selected subsets of clients; and based upon the client's general information; giving the client's personal information to the supplier when the client accepts one of the offers. However, in col. 2, lines 15-50, col. 4, lines 20-60 thereof, Motoyama disclose(s) selecting products for a client based on client information(pre-approved offers), and then giving the client information to suppliers when the client selects the offer(product). It would be obvious to one of ordinary skill in the art to modify the invention of Walker at al. based on the teachings of Motoyama. The motivation to combine these references is effectively and efficiently meet the clients needs for uniquely designed products.

Re claims 2, and 18: Walker at al. disclose(s) the claimed invention except the general information comprises a client's age, sex, race, citizenship, and zip code. However, in col. 6, lines 45-67, Motoyama disclose providing client preferences when the client enters the system. The personal preference information for financial analysis has to include age, sex, race, citizenship and zip for the computer to select the right financial instrument suitable for the client. It would be obvious to one of ordinary skill in the art to modify the invention of Walker at al. based on the teachings of Motoyama. The motivation to combine these references is effectively and efficiently meet the clients needs for uniquely designed products.

Re claims 7 and 23: Walker at al. disclose(s) the claimed invention except wherein the personal information that uniquely identifies the client comprises the client's name, social security number, street

address, mother's maiden name, or phone number. However, in col. 6, lines 45-67, Motoryama disclose providing client preferences when the client enters the system. The personal preference information for financial analysis has to include client's name, social security number, street address, mother's maiden name, or phone number for the computer to select the right financial instrument suitable for the client. It would be obvious to one of ordinary skill in the art to modify the invention of Walker et al. based on the teachings of Motoyama. The motivation to combine these references is effectively and efficiently meet the clients needs for uniquely designed products.

Re claims 8, 9, 24, 25, 36,37, and 38: Walker et al. disclose enabling suppliers of products and services to select subsets of clients by validating that the general information used to select subsets of clients correspond to a client who can be uniquely identified with personal information.

And supplying suppliers with a digital certification to validate the general information as corresponding to a client(Abstract, col. 12, lines 20-35, col. 13, lines 10-25, col. 26, lines 50-67, col. 27, lines 1-20).

Re claims 10, 14, 26, and 34: Walker et al. disclose using a computer system to compile the plurality of client files, enable suppliers to select subsets of clients based upon the client's general information, receive pre-approved offers from said suppliers on behalf of the selected subsets of clients, and give the client's personal information to the supplier after the client accepts the supplier's offer(Abstract, col. 16, lines 45-67, col. 18, lines 14-67, col. 19, lines 30-60).

Re claims 11, 16, 27 and 35: Walker et al. disclose storing the plurality of client files as a database in a computer readable medium(col. 12, lines 20-67);
accessing the computer system via a network connection to select subsets of clients and transmit pre-approved offers to the computer system(col. 20, lines 5-30); and
accessing said computer system via a network connection to view pre-approved offers and select the desired offer(col. 13, lines 10-67).

Re claims 12 , 15, 28. Walker et al. disclose supplying the client with pre-approved offers for goods and services with better terms than offers that the client has already accepted(Abstract, col. 10, lines 1-30, col. 12, lines 5-40).

Re claims 40, 41, 42, 43, 44: Walker et al. disclose including operating a processor that compares the criteria to the anonymous transaction profile. The processor applies a table or an algorithm containing the criteria to the anonymous transaction profile. And having a supplier operate the processor. And having an intermediary operate the processor. And the processor is an operator that manually compares the criteria to the anonymous transaction profile(col. 8, lines 25-67, col. 10, lines 55-67, col. 12, lines 20-35, col. 13, lines 1-25, col. 14, lines 10-55).

Re claim 45: Walker et al. disclose including using a registry service to supply the anonymous transaction profile to one or more processors(col. 15, lines 10-50).

Re claim 46. Walker et al. disclose including supplying offers to consumers or distributors through the registry service(col. 13, lines 5-65).

Re claim 47. Walker et al. disclose receiving a request for offer at a distributor computer;

using the distributor computer to separate the request for offer into anonymous information and personal information;

using the distributor computer to submit the anonymous information and personal information for offer to a third party;

using the distributor computer to receive third party information from the third party(col. 8, lines 25-67, col. 10, lines 55-67, col. 12, lines 20-35, col. 13, lines 1-25, col. 14, lines 10-55), and

using the distributor computer to generate the anonymous transaction profile from the anonymous information and the third party information(col. 8, lines 25-67, col. 10, lines 55-67, col. 12, lines 20-35, col. 13, lines 1-25, col. 14, lines 10-55).

Re claim 48: Walker et al. disclose including:

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generating a personal information record from the personal information and the third party information; and submitting the personal information record to a supplier when an offer is accepted by a consumer(col. 8, lines 25-67, col. 10, lines 55-67, col. 12, lines 20-35, col. 13, lines 1-25, col. 14, lines 10-55).

Re claim 49: Walker et al. disclose generating the offer before knowing a personal identity of a consumer associated with the anonymous profile(col. 8, lines 25-67, col. 10, lines 55-67, col. 12, lines 20-35, col. 13, lines 1-25, col. 14, lines 10-55).

Re claim 50: Walker et al. disclose including sending personal information of the consumer to a supplier of the offer only when the consumer accepts the offer(col. 8, lines 25-67, col. 10, lines 55-67, col. 12, lines 20-35, col. 13, lines 1-25, col. 14, lines 10-55).

Re claim 51. Walker et al. disclose encrypting the anonymous transaction profile and using a consumer password associated with the anonymous transaction profile as a key for decrypting the encrypted transaction profile(col. 25, lines 1-40).

Re claim 52. Walker et al. disclose adding different consumer requirements to the criteria used for comparing with the anonymous transaction profile(col. 13, lines 5-65, i.e. can add the different criteria into the databases named in this col.).

Re claim 53. Walker et al. disclose adding different distributor requirements to the creditor used for comparing with the anonymous transaction profile(col. 13, lines 5-65, i.e. can add the different criteria into the databases named in this col.).

Re claim 54. Walker et al. disclose adding different supplier requirements to the anonymous transaction profile used for comparing with the criteria(col. 13, lines 5-65, i.e. can add the different criteria into the databases named in this col.).

Re claims 55 – 58: Walker et al. disclose all the other things in this claims and also disclose wireless (col. 18, lines 30-45)

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4. Claim 3,19,39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker at al. and Motoyama as applied to claim 2 above, and further in view of Saladin et al.(5262941).

Re claim 3,19, 39: Walker at al. and Motoyama disclose(s) the claimed invention except of a client's credit rating. However, in the Abstract, col. 2, lines 15-45 Saladin et al. disclose credit rating. It would be obvious to one of ordinary skill in the art to modify the invention of Walker at al. and Motoyama based on the teachings of Saladen et al. The motivation to combine these references is effectively and efficiently meet the clients needs for uniquely designed products.

Claim 4 and 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker at al. and Motoyama as applied to claim 2 above, and further in view of Eberhardt(5832488).

Re claim 4: Walker at al. and Motoyama disclose(s) the claimed invention except client's medical history. However, in the Abstract, Eberhardt disclose medical history. It would be obvious to one of ordinary skill in the art to modify the invention of Walker at al. and Motoyama based on the teachings of Eberhardt. The motivation to combine these references is effectively and efficiently meet the clients needs for uniquely designed products.

5. Claim 5, 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker and Motoyama as applied to claim 1 above, and further in view of Coulter et al. and Eberhardt.

Re claims 5, and 21: Walker at al. disclose compiling client files and obtaining pre-approved offers for any product or service that requires evaluation(Abstract, col. 8, lines 25-67).

Walker at al. and Motoyama disclose(s) the claimed invention except of a client's credit rating. However, in the Abstract, col. 2, lines 15-45 Saladin et al. disclose credit rating. It would be obvious to one of ordinary skill in the art to modify the invention of Walker at al. and Motoyama based on the teachings of Saladen et al. The motivation to combine these references is effectively and efficiently meet the clients needs for uniquely designed products.

Walker at al. and Motoyama disclose(s) the claimed invention except client's medical history. However, in the Abstract, Eberhardt disclose medical history. It would be obvious to one of ordinary skill in the art to modify the invention of Walker at al. and Motoyama based on the teachings of Eberhardt. The motivation to combine these references is effectively and efficiently meet the clients needs for uniquely designed products.

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Re claims 6 and 22: Walker at al. disclose(s) the claimed invention except using the same client file multiple times to make offers for different products and services; and updating the client file when existing information becomes inaccurate or when more information is required in conjunction with another product or service. However, in col. 6, lines 25-67, Motoryama disclose a database of information about the client and since all databases can be updated, it is obvious that this database also can be updated. It would be obvious to one of ordinary skill in the art to modify the invention of Walker at al. based on the teachings of Motoyama. The motivation to combine these references is effectively and efficiently meet the clients needs for uniquely designed products.

6. Claims 29, 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. and Mandler et al. (5732400A).

Re claims 29, 30 and 31. Walker et al. disclose an anonymous transaction system(col. 12, lines 20-35, col. 13, lines 10-25, col. 26, lines 50-67, col. 27, lines 1-20), comprising:

one or more processors configured to receive first party data and convert the first party data into an anonymous profile(col. 12, lines 20-35, col. 13, lines 10-25, col. 26, lines 50-67, col. 27, lines 1-20); at least one of the processors configured to receive criteria from a second party for providing a transaction(col. 12, lines 20-35, col. 13, lines 10-25, col. 26, lines 50-67, col. 27, lines 1-20), and

at least one of the processors configured to initiate the transaction when the anonymous profile meets the criteria(col. 12, lines 20-35, col. 13, lines 10-25, col. 26, lines 50-67, col. 27, lines 1-20). And at least one of the processors automatically generates offers for multiple suppliers according to the anonymous profile. And at least one of the processors applies after the anonymous profile has been determined to meet the criteria(col. 12, lines 20-35, col. 13, lines 10-25, col. 26, lines 50-67, col. 27, lines 1-20).

Walker et al. disclose(s) the claimed invention except risk based pricing. However, in col. 4, lines 40-65, col. 5, lines 5-20 thereof, disclose(s) Mandler et al. disclose risk-based pricing. It would be obvious to one of ordinary skill in the art to modify the invention of Walker et al. based on the teachings of Mandler et al. The motivation to combine these references is to more effectively and effectively do pricing.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra F. Charles whose telephone number is (703) 305-4718. The examiner can normally be reached on 9-5 Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A. Millin can be

reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Debra F. Charles
Examiner
Art Unit 3624

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